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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,638	11/24/2003	Nareak Douk	P1714	1187
28390 7590 12/12/2008 MEDTRONIC VASCULAR, INC. IP LEGAL DEPARTMENT 3576 UNOCAL PLACE SANTA ROSA, CA 95403				
EXAMINER KOEHLER, CHRISTOPHER M				
ART UNIT		PAPER NUMBER		
3726				
NOTIFICATION DATE		DELIVERY MODE		
12/12/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

rs.vasciplegal@medtronic.com

### Office Action Summary

**Application No.**

10/718,638

**Applicant(s)**

DOUK ET AL.

**Examiner**

Christopher M. Koehler

**Art Unit**

3726

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 September 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6, 8-23, 26-33, 37-39 and 41 is/are pending in the application.  
4a) Of the above claim(s) 3, 6, 8, 12-17, 21, 22, 26-33, 37-39 and 41 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1, 2, 4, 5, 9-11, 18-20 and 23 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 4/19/04, 4/27/05, 5/26/05, 1/4/08  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of claims 1, 2, 4, 5, 18-20 and 23 in the reply filed on 9/3/2008 is acknowledged. Regarding applicant's traversal of the restriction between claims 9-11, applicant's admission that claim 11 is an obvious variant of claims 9 and 10 is sufficient for withdrawal of the restriction regarding claims 9-11.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 2, 4, 5, 18-20 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Kusleika et al. (US Patent No. 6,325,815).

**Claims 1 and 20:**

Kusleika teaches a method for manufacturing a distal protection element (figure 1) for preventing emboli in a blood vessel from moving away from a treatment site during a vascular procedure (col. 4, lines 25-32), the method comprising braiding a plurality of filaments to form an enclosure having a wall thickness (col. 3, line 63-col. 4, line 16); forming the braided enclosure to have a first end region and a second end region (figure 1), each of the first and second end regions having a taper region (figure 1) and a neck region (60, 65) adapted for attachment to a guidewire (20, col. 3, lines 17-32); and reducing the wall thickness of the enclosure along at least a portion of the first

end region (the wall thickness is reduced to 0 in the first end region at the location of the aperture).

Claims 2 and 4:

Kusleika teaches heat treating the filaments of the braided distal protection element after the reducing step (col. 5, lines 4-10).

Claim 5:

Kusleika teaches that the protection element is a capture element (abstract).

Claims 18 and 19:

Kusleika teaches that the filaments comprise metal nitinol tubing wires (col. 4, lines 2-16).

Claim 23:

Kusleika teaches that the reducing step involves removing material in a longitudinally striped pattern (the aperture formed by cutting is a stripe along the longitudinal axis of the device) (figure 1, col. 5, lines 4-10).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kusleika in view of Gilson et al. (US Patent No. 6,336,934).

Claims 9-11:

Kusleika teaches that the reducing step comprises cutting or by any suitable fashion (col. 5, lines 4-10) but does not explicitly teach etching.

Gilson teaches a distal protection device used to capture emboli in blood vessels (abstract) wherein the device is reduced by chemical etching (col. 11, lines 5-7).

It would have been obvious to one of ordinary skill in the art at the time of invention to apply the chemical etching of Gilson to the reducing of Kusleika as one of many suitable methods for reducing the device. It is noted here that although neither Gilson nor Kusleika teaches acid pickling it is admittedly an obvious variant of etching and thus would have been obvious to one of ordinary skill in the art.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher M. Koehler whose telephone number is (571)272-3560. The examiner can normally be reached on Mon.-Fri. 7:30A-4:00P.
7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David P. Bryant can be reached on (571) 272-4526. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.
8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

Art Unit: 3726

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jermie E Cozart/  
Primary Examiner, Art Unit 3726

/C. M. K./  
Examiner, Art Unit 3726

December 8, 2008